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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RUTLEDGE, AMELIA L

ART UNIT	PAPER NUMBER
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2176

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/814,554

Applicant(s)

HAILEY ET AL.

Examiner

Amelia Rutledge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-51 is/are pending in the application.
- 4a) Of the above claim(s) 31-33 and 47-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-30 and 34-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Response to Election/Restriction, filed 12/11/2006; original application, filed 03/31/2004.
2. Claims 25-30 and 34-46 are pending in the case. Claims 25 and 34 are independent claims.
3. Applicant's election without traverse of claims 25-30 and 34-46 in the reply filed on 12/11/2006 is acknowledged.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25-30 and 34-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 25-30 and 34-46 describe a computer readable medium having a schema for a document generation system (claims 25-30), and a computer readable medium having a data structure for a document (claims 34-46), and describe the various elements included in the schema and data structure. As such, claims 25-30 and 34-46 are directed to nonfunctional descriptive material, and claim mere arrangements or compilations of facts or data, without any functional interrelationship. For example, claim 34 claims a data structure for a document, and a collection of elements, but does not claim a functional interrelationship among that data and the computing processes performed when utilizing that data. The claimed invention should demonstrate how the

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data structure is used and how it causes functional change in the computer, and returns a practical result.

The following passage from the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* (hereinafter "*Interim Guidelines*"), p. 55, emphasis added, further explains nonfunctional descriptive material.

Nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. § 101. Certain types of descriptive material, such as music, literature, art, photographs and **mere arrangements or compilations of facts or data, without any functional interrelationship** is not a process, machine, manufacture or composition of matter. USPTO personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. § 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.

As claimed, claims 25-30 and 34-46 are also non-statutory because they do not meet the practical application requirement. Claims 25-30 and 34-46 do not produce a useful, concrete, and tangible result, because they describe only a data structure and schema. See *Interim Guidelines*, p. 37-39.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 35 and 36 recite the limitation "*template element*" in line 2 (Claim 35) and line 3 (claim 36). There is insufficient antecedent basis for this limitation in the claims, because claims 35 and 36 depend from claim 34, which recites a *template root element* and a *template information element*, however, a *template element* is not claimed in claim 34. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 25-30 and 34-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Mohr et al. (hereinafter "Mohr"), U.S. Patent No. 6,826,727 B1, issued November 2004.

Regarding independent claim 25, Mohr teaches a computer readable medium having a schema for a document generation system, since Mohr teaches a system for laying out documents with flexible layout process and variable data publishing system (col. 2, l. 40-col. 6, l. 38; Abstract). Mohr teaches that the schema comprises a template root element (col. 11, l. 10, l. 43-col. 11, l. 26; col. 13, l. 39-67); a template information element (col. 13, l. 22-67); a data table element (col. 11, l. 60-col. 24; col. 12, l. 65-col. 13, l. 38), since Mohr teaches content mapping rules to map variable data from a database table (col. 13, l. 2-6), i.e., a data table element. Mohr teaches that the schema comprises an instances element, which describes how each individual instance of the document is constructed (col. 14, l. 29-45; col. 11, l. 10, l. 43-col. 11, l. 26; col. 13, l. 39-67), since Mohr teaches dynamically mapping files into a template container that is a variable element (col. 13, l. 39-67).

Regarding dependent claim 26, Mohr teaches that the instances element is configurable to include a pages element (col. 11, l. 43-59), an overlays element, i.e., layout box element (col. 11, l. 26-42), a continuations element, i.e., element for designating size and positioning (col. 11, l. 20-59; col. 14, l. 29-45), and a data element (col. 13, l. 6-38).

Regarding dependent claim 27, Mohr teaches that the pages element is configurable to include a page element and the page element is configurable to include an overlays element and a composition element (col. 14, l. 59-col. 15, l. 12), since Mohr teaches that certain template elements can be mapped to variable elements, and Mohr teaches mapping variable text elements (col. 11, l. 42-col. 12, l. 24), the nesting of elements to include other elements, and mapping of content into box elements and shape elements (col. 13, l. 6-21; col. 14, l. 29-45).

Regarding dependent claim 28, Mohr teaches that the overlays element is configurable to include one or more overlay elements, which is implied by the disclosure of nested elements (col. 11, l. 2-26) and the mapping of variable values (col. 12, l. 16-col. 13, l. 38).

Regarding dependent claim 29, Mohr teaches that the continuations element is configurable to include one or more continuation elements and one or more overflow default elements, which is implied by the disclosure of nested elements (col. 11, l. 2-26) and the mapping of variable values (col. 12, l. 16-col. 13, l. 38; col. 25, l. 8-24).

Regarding dependent claim 30, Mohr teaches that the data element is configurable to include one or more datum elements, which is implied by the disclosure of nested elements (col. 11, l. 2-26) and the mapping of variable values (col. 12, l. 16-col. 13, l. 38).

Regarding independent claim 34, Mohr teaches a computer readable medium having a schema for a document generation system, since Mohr teaches a system for laying out documents with flexible layout process and variable data publishing system (col. 2, l. 40-col. 6, l. 38; Abstract). Mohr teaches that the schema comprises a template root element (col. 11, l. 10, l. 43-col. 11, l. 26; col. 13, l. 39-67); a template information element (col. 13, l. 22-67); a data table element (col. 11, l. 60-col. 24; col. 12, l. 65-col. 13, l. 38), since Mohr teaches content mapping rules to map variable data from a database table (col. 13, l. 2-6), i.e., a data table element. Mohr teaches that the schema comprises an instances element, configured to describe how a document is constructed (col. 14, l. 29-45; col. 11, l. 10, l. 43-col. 11, l. 26; col. 13, l. 39-67), since Mohr teaches dynamically mapping files into a template container that is a variable element (col. 13, l. 39-67).

Regarding dependent claim 35, Mohr teaches that the template information element includes descriptive information about the template element (col. 13, l. 22-67).

Regarding dependent claim 36, Mohr teaches that the descriptive information includes a title element that contains a title for the document at hand (Fig. 50, items 130C, 130D, and 130E), a description element that is a container for free-form text about the template element (col. 13, l. 6-38), a help text element, which is a container for free-form information that may be useful to a consumer of the document (col. 13, l.

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6-38), and Mohr implies a document type element that is provided to support a type element from other schemas or DTDs (col. 12, l. 65-col. 13, l. 38), since Mohr teaches using content mapping rules, the association of outside files, and mapping element content to a digital asset management system.

Regarding dependent claim 37, Mohr teaches that the template information element includes a print constraints element which is a container for special values that may be needed or used by a printing environment (col. 41, l. 3-55).

Regarding dependent claim 38, Mohr teaches that the data table element includes data values to be used in a specific instance of a template, (col. 14, l. 29-45; col. 11, l. 10, l. 43-col. 11, l. 26; col. 13, l. 39-67), since Mohr teaches dynamically mapping files into a template container that is a variable element (col. 13, l. 39-67).

Regarding dependent claim 39, Mohr teaches that the data table element defines a structure of data values that can be accessed by name, or by a combination of name and one or more indices (col. 12, l. 17-col. 13, l. 37).

Regarding dependent claim 40, Mohr teaches that the instances element is configured to include one or more instance elements, which is implied by the disclosure of nested elements (col. 11, l. 2-26) and the mapping of variable values (col. 12, l. 16-col. 13, l. 38).

Regarding dependent claims 41-45, claims 41-45 are directed to substantially similar subject matter as claimed in claims 26-29, and are rejected along the same rationale.

Regarding dependent claim 46, Mohr teaches that continuation elements are configured to be used by a processor to process overflows (col. 42, l. 36-col. 43, l. 63).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia Rutledge whose telephone number is 571-272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO


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Technology Center 2176